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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

Zen 017

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 07-11-06

Signature

Typed or printed name A. J. O'Lenick, Jr

Application Number

10/620,899

Filed

07/17/2003

First Named Inventor

LA Vay

Art Unit

1655

Examiner

Heller, Michael

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☒ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

A. J. O'Lenick, Jr

Typed or printed name

678-442-0410

Telephone number

07/09/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Notice of Appeal

In re Application of: O'Lenick

Examiner: Meller, Michael V.

Group Art Unit: 1655

Serial No: 10/620,899

Filed: 07/17/2003

Title: Cranberry Alkoxy Esters as a Delivery System for Natural Antioxidants

Honorable Commissioner
Patents and Trademarks
P.O. Box 1450
Alexandria Va.

Sir:

Please enter the following *Notice of Appeal* in response to the office action dated
06/27/20.

Applicant submits herewith:

1. Notice of Appeal (PTO/SB/31)
2. Listing of Claims under appeal
3. Pre-Appeal Brief Request for Review Form (PTO/SB/33) (5 pages)
4. Pre Appeal Brief
5. Fee as required.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Listing Claims Under Appeal

In re Application of: O'Lenick

Examiner: Meller, Michael V.

Group Art Unit: 1655

Serial No: 10/600,251

Filed: 05/27/2003

Title: Cranberry Amido Amines and Betaines as a Delivery System for Natural Antioxidants

1. Claims Under Appeal: 1-9.

Having been twice and finally rejected claims 1-2 are appealed.

2. Claims to be Rejoined: 10-19

Claims 1-9 are directed toward a compound, and claims 10-19 are directed toward the use of the novel compound. Using the policy established by USPTO relating to rejoining claims directed to a process for using compounds be rejoined once the compound claims have been allowed.

Respectfully submitted:



Anthony J. O'Lenick, Jr.
Applicant
July 10, 2006
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Dacula, Ga. 30019



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Pre Appeal Brief Request for Review

In re Application of: O'Lenick

Examiner: Meller, Michael V.

Group Art Unit: 1655

Serial No: 10/620,899

Filed: 07/17/2003

Title: Cranberry Alkoxy Esters as a Delivery System for Natural Antioxidants

Applicant respectfully traverses the only rejection 35 USC 112 (first paragraph) and offers the following information for consideration by the panel.

1. The only rejection and issue at hand is a rejection under 35 USC 112, first paragraph as failing to comply with the written description. The office action dated June 27, 2006 states " There is no chemical structure for "R" and since that is the case is it not clear what "R" is. It is defined as derived from cold pressed cranberry, but without a chemical structure of it, it is not adequately defined by the instant specification". This statement clearly defines the appeal.

2. Clearly, the issue is if the only acceptable method of naming the natural oil from which the compounds of the present invention are derived is with words like ""R" is alkyl having x to y carbon atoms". Applicant rejects the contention. The Federal Circuit has clearly articulated the position that definiteness must be analyzed in light of (1) the content of a particular application disclosure, (2) teachings of the prior art, (3) claim interpretation that would be given by one possessing the ordinary level of skill in the art.

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(Ref: In Re Marosi, 710 F.2d 218, U.S.P.Q. 289 (Fed Cir 1983); Rosemount Inc. v. Beckman Instruments Inc. 727 F.2d 1540, 221 U.S.P.Q. 1 (Fed Cir 1984).

The term “R is derived from cold pressed cranberry seed oil” as written complies fully with the requirements of 35 USC 112 (first paragraph). There is nothing of record to indicate to the contrary except opinion. The application painstakingly specifies the oil, the genus and species from which it is derived, a patent enabling the term cold pressed, and the information that is known about the composition. ([014] to [023] of the application, and buttressed the argument with an affidavit under 37 CFR 1.132.

3. Applicant respectfully contends that the language saying R is derived from cold pressed cranberry seed oil has proper antecedent basis and complies with 35 USC 112. The alkyl chain and the other listed elements are present in cold pressed cranberry oil. Applicant respectfully contends that the patent literature is replete with many examples of natural products claimed using a specific oil. The specific way the applicant has defined the oil not only complies with 35 USC 112 but to deny the claims would deny the applicant the present invention. The claims not only enable one of ordinary skill in the art to practice the current invention, the invention as claimed defined cold pressed oil in the most particular way possible.

4. Applicant respectfully contends that natural products like polymers are complex mixtures of species made up described by the inventor in great detail in the specification and confirmed in the Steinberg Declaration. Applicant points out that by describing the “R” group as requested by the current office action with a certain alkyl chain length would not work since the product so described could be made by blending oils or fatty acids that are not the specified cold pressed oil and would not be functional. Such a

description would not define the present invention in full, clear and concise and exact terms as to enable any person skilled in the art to which it pertains ... to carry out the invention. The natural oils that are described as “derived from cold pressed oil” tell the genus and species of the plant from which they are derived, the method of processing the oil, and the antioxidant materials present. It is the only way to describe the product the inventor claims as his invention.

5. Applicant respectfully contends that the pertinent portion of 112 is second paragraph not first which states;

¶ 7.34.01 Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point out and Distinctly Claim (Indefinite)

Claim [1] rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.2. This form paragraph should be followed by one or more of the following form paragraphs 7.34.02 - 7.34.11, as applicable. If none of these form paragraphs are appropriate, a full explanation of the deficiency of the claims should be supplied. Whenever possible, identify the particular term(s) or limitation(s) which render the claim(s) indefinite and state why such term or limitation renders the claim indefinite. If the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would not be appropriate. (Emphasis added)

This requirement of the MPEP has not been addressed and is not of record, despite an expert opinion to the contrary. Clearly, the scope of the claimed subject matter can be determined by one having ordinary skill in the art, and consequently a rejection using this form paragraph would not be appropriate. Applicant, while pro-se, has not been afforded information required by the MPEP as indicated above despite several requests.

6. Applicant is most confused by the status of claims 10-19, and reason cited for the position. What is not clear is the basis for the status of claims 10-19. Despite the fact that only claims 1-9 are currently pending and claims 10-19 are withdrawn, USPTO rules require rejoinder if the former are allowed since claims 1-9 are directed toward a compound, and claims 10-19 are directed toward the use of the novel compound. The latter claims will be rejoined if claims directed to the compounds were allowed.

Applicant cannot determine from the action if it is the position that claims 10-19 will not be rejoined or not, and if not, the applicant cannot determine the basis for the position.

Conclusion: The definition of Cold Pressed oils as defined is clear the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would be appropriate. The present rejection fails to identify the particular term(s) or limitation(s) which render the claim(s) indefinite and state why such term or limitation renders the claim indefinite.

Applicant respectfully requests reconsideration of the pending claims by the panel

Respectfully submitted:



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